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Art Unit 2511

Paper No. 14

FEB 22 1993

Appeal No. 92-3748

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Ole K. Nilssen

Application for Patent filed September 10, 1990, Serial No. 579,569; which is a continuation-in-part of application Serial No. 787,692, filed October 15, 1985; which is a continuation of Serial No. 644,155, filed August 27, 1984, now abandoned; which is a continuation of application Serial No. 555,426, filed November 23, 1983, now abandoned; which is a continuation of application Serial No. 178,107, filed August 14, 1980, now abandoned. Electronic Ballast Cathode Heating Circuit.

Ole K. Nilssen, pro se.

Supervisory Patent Examiner - Eugene R. Laroche
Examiner - Son Dinh

Before Hairston, Krass and Cardillo, Examiners-in-Chief.

Cardillo, Examiner-in-Chief.

REMAND TO THE EXAMINER

Paper No. 13, mailed August 25, 1992, indicates that appellant's Reply Brief (Paper No. 12, filed June 15, 1992) has not been entered. In this regard we note that the Manual of Patent Examining Procedure (M.P.E.P.) does in fact interpret 37 CFR § 1.193(b) as requiring "that any amendment or other material

appropriate to the new ground of rejection must be presented in a separate paper, rather than in the reply itself" and goes on to note that this rule "requires that the appellant be notified if the reply brief is not entered because of non-compliance with the rule" (see the last paragraph of M.P.E.P. § 1208.03(2)).

What is not expressly set forth, however, is that appellant should be allowed one month to correct this defect just as appellant would have been allowed one month to correct any failure to respond to a new ground of rejection in an entered reply brief (note the penultimate paragraph of M.P.E.P. § 1208.03(2) as to allowing one month to provide an omitted reply brief response to a new ground of rejection in a supplemental reply brief). If this is not done here, this appeal must be dismissed because no arguments as to the new ground of rejection are of record for us to consider.

Therefore, we follow the penultimate paragraph of M.P.E.P. § 1208.03(2) and remand this application to the examiner to duly notify appellant of the consequences of not correcting the defect as well as setting forth a time period for making the correction. In addition, while this application is in the jurisdiction of the examiner, the oversight of not providing a copy of the newly cited Cox patent¹ to appellant and a form PTO-


¹U.S. 3,691,450 issued September 12, 1972.


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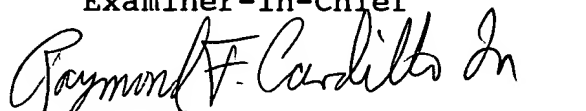
892² for the record should also be corrected. In this last respect, the examiner may wish to consider the normal corrective procedure for the oversight of not providing a reference suggested by M.P.E.P. § 707.05(g).

This application, by virtue of its "special" status, requires an immediate action, M.P.E.P. § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED


Kenneth W. Hairston
Examiner-in-Chief


Errol A. Krass
Examiner-in-Chief


Raymond F. Cardillo, Jr.
Examiner-in-Chief

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²We note that this patent should have been listed in the answer under a caption "New Reference" and that a PTO-892 should have been completed for the file as well as mailing a copy of the new reference with the answer. See M.P.E.P. § 1208.01 and also note the requirement found therein that "[t]he supervisory primary examiner will stamp 'approved' and sign his or her approval" and not merely sign the answer as was done here.